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EXAMINER

BARTUSKA, FRANCIS JOHN

ART UNIT	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 11

Application Number: 09/449,426
Filing Date: November 24, 1999
Appellant(s): MEEK ET AL.

MAILED

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GROUP-3600

Ralph E. Jocke
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 14 May 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-55 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

5,305,195	MURPHY	4-1994
EP 0843291	PATTERSON et al	5-1998
6,039,245	SYMONDS et al	3-2000

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 47, 51 and 55 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Murphy. Murphy shows an interactive

advertising system for on-line terminals including receiving a credit card at 14 or 80, receiving transaction requests, see col. 6, lines 53-59 and col. 7, lines 46-50, sending transaction information to a marketing computer 10 or 30, sending transaction information to a transaction computer 22 or 36, selecting a presentation to be made to a user, see col. 3, lines 59-68 and col. 4, lines 64-68, sending a transaction response from the transaction computer and carrying out a financial transaction, see col. 6, lines 57-59 and presenting a coupon, see col. 2, lines 59-68 and col. 7, lines 46-50. In col. 1, line 43 to col. 2, line 8 Murphy discloses accessing the marketing computer during the waiting times at the ATM terminal.

2. Claims 1-29, 31-34, 36-46, 48, 49, 52, 53 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy in view of EPO publication 0843291, both of record. Murphy shows an interactive advertising system for on-line terminals including receiving a credit card at 14 or 80, receiving transaction requests, see col. 6, lines 53-59 and col. 7, lines 46-50, sending transaction information to a marketing computer 10 or 30, sending transaction information to a transaction

computer 22 or 36, selecting a presentation to be made to a user, see col. 3, lines 59-68 and col. 4, lines 64-68, sending a transaction response from the transaction computer and carrying out a financial transaction, see col. 6, lines 57-59 and presenting a coupon, see col. 2, lines 59-68 and col. 7, lines 46-50. Murphy does not disclose selecting presentations in response to user data. EPO publication 0843291 discloses an ATM that selects presentations in response to customer information, see col. 2, lines 32-50, in order to provide an appropriate display. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of the EPO publication 0843291 to modify the system of Murphy to select presentations in response to customer information in order to provide an appropriate display.

3. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy in view of EPO publication 0843291, both of record.

Murphy shows an interactive advertising system for on-line terminals including receiving a credit card at 14 or 80, receiving transaction requests, see col. 6, lines 53-59 and col. 7, lines 46-50, sending transaction information to a marketing computer 10 or 30, sending

transaction information to a transaction computer 22 or 36, selecting a presentation to be made to a user, see col. 3, lines 59-68 and col. 4, lines 64-68, sending a transaction response from the transaction computer and carrying out a financial transaction, see col. 6, lines 57-59 and presenting a coupon, see col. 2, lines 59-68 and col. 7, lines 46-50.

Murphy does not disclose selecting as the next presentation one that has not been previously viewed. EPO publication 0843291 discloses an ATM that prevents a re-run of a previous sales presentation to the same user, see col. 3, lines 51-54. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of the EPO publication 0843291 to modify the system of Murphy to prevent re-running the same presentation to the same user in order to provide a greater chance of making a sale.

4. Claims 30 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy in view of EPO publication 0843291 as applied to claim 1 above in further view of Symonds et al. Murphy, as modified by EPO publication 0843291, shows all the features of the applicants' claims except the particular message format. Symonds et al

teach in col. 11, lines 6-17 that the message format ISO 8583 is common in automated transaction machines. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Symonds et al to use ISO 8583 message format in the automated transaction machines of Murphy.

(11) Response to Argument

Because the appellants have not maintained consistency in referring to the first and second computers, the examiner will refer to the computers as the marketing computer and the transaction computer. As an example of the inconsistency: in claim 1 paragraphs (c), (e) and (f) refer to the marketing computer as the first computer, while in claim 47 paragraph (b) the marketing computer is the second computer.

Re claims 47, 51 and 55 the appellants argue that Murphy does teach performing the marketing step concurrently with the financial transaction step. The appellants argue that in both embodiments of Figures 1 and 2 of Murphy the advertisements from the marketing computer 10 or 30 are stored on the hard disc 18 prior to a financial

transaction. It is the examiner's position that in the Figure 1 embodiment of Murphy the advertisements are transferred from the marketing computer 10 during the periods when the ATM user is waiting for a response from the transaction computer 22. The Figure 1 embodiment of Murphy includes dedicated co-axial long lines 24 which have the necessary bandwidth to handle video signals for display on the video display 20 of the ATM, see col. 4, lines 45-51. Col. 1, lines 43-51 and col. 4, lines 54-68 of Murphy disclose that the advertising message is displayed only during the waiting time of the transaction computer driving the ATM. In col. 1, line 66 to col. 2, line 8, Murphy discloses that the co-axial lines handle the wide bandwidth of the video signal for display during waiting periods. The Figure 1 embodiment of Murphy is disclosed in col. 1, line 35 to col. 2, line 8 and in col. 4, line 34 to col. 5, line 10. Nowhere in the disclosure of the Figure 1 embodiment of Murphy is it stated that the video signal is stored on the hard disc 18. The disclosure in col. 2, lines 50-54 of Murphy:

"The compressed video signal being transmitted from the commercial computer to each of the servers can be transmitted over telephone lines for storage in the hard disc

thereby eliminating the need for dedicated wide bandwidth lines such as co-axial lines.”

makes it quite clear that the signals transmitted on the dedicated wide bandwidth co-axial lines 24 of the Figure 1 embodiment are not stored on the hard disc. While Murphy discloses that the Figure 1 embodiment is not the preferred embodiment, it is still available prior art under 35 USC 102(b).

The appellants argue that Murphy does not teach installing software on the ATM to enable communication between the ATM and the marketing computer. It is the examiner's position that there can be no question that the computers and the ATM of Murphy run on software that enables the communications over the lines 24 or 32. The software could only be present on the devices if installed at some prior time.

The appellants argue that the combination of Murphy and Patterson is not proper because Murphy requires that the marketing computer 10 remains independent from the transaction computer 22; while Patterson teaches transaction computer and marketing computer dependency. It is the examiner's position that the independence of the

computers of Murphy does not have to be compromised to include the teaching from Patterson. Patterson teaches retrieving ads from the ads source 16 after a match has been found between the customer information and the product profiles by the host computer 18.

Likewise, in the combination of Murphy and Patterson as proposed in the rejections, a marketing message would be retrieved from the marketing computer 10 of Murphy after a match was made between the customer information in the transaction computer 22 and a product profile associated with the transaction computer. In that way, the independence of the computers of Murphy is maintained, the customer profiles are matched to the product profile in the host computer as taught by Patterson and the ads are retrieved from the ad source as taught by Murphy and Patterson. The appellants' argument that Patterson must include an independent marketing computer in order to be properly combinable with Murphy must not be found persuasive because that is requiring that a secondary reference must anticipate the claimed invention in order to be a proper secondary reference. A teaching can be gleaned from a secondary reference without the

secondary reference being exactly like the primary reference; otherwise, there would never be a need to combine references, since the secondary reference shows all the features of the primary reference the secondary reference would become the primary reference.

The appellants argue that the rejections based on Murphy in view of Patterson are devoid of any teaching, suggestion or motivation for the combination. It is the examiner's position that the teaching in col. 2, lines 51-55 of Patterson to make the best match between the product display and the user results in the highest possibility of making a sale is sufficient motivation to combine the references.

The appellants argue that Symonds does not disclose using a marketing message with an ISO 8583 message format. The rejections rely upon Murphy for disclosure of sending a marketing message. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further, if the ISO format

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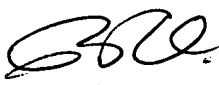
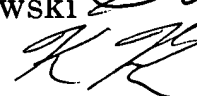
of Symonds can handle any kind of message there is no apparent reason why it would not handle a marketing message.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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PRIMARY EXAMINER 7-8-03

fjb
July 8, 2003

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